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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,038	11/13/2003	Satoshi Ishikawa	0042-0491P	7110
2292 7590 09/10/2010 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER FELTON, MICHAEL J				
ART UNIT		PAPER NUMBER		
1791				
NOTIFICATION DATE		DELIVERY MODE		
09/10/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/706,038

Applicant(s)

ISHIKAWA ET AL.

Examiner

MICHAEL J. FELTON

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/ISD)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 12/23/2010

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/30/2009 has been entered.

Response to Arguments

2. Applicant's arguments filed 9/30/2009 have been fully considered but they are not persuasive.
3. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Yamazaki does not suggest lowering the amount of calcium carbonate in the surface layer) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
4. In response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the

claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, there are several known paper making techniques in the art. Yamazaki teach one technique, making a handsheet. Smook is used to show that there are other known techniques, and that twin wire formers are used to make tissue and wrappers.

5. In response to applicant's arguments, the recitation twin-wire has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In this case, the applicant is arguing that an undisclosed structural attribute should be given patentable weight based on a process description in the preamble. The examiner considers the statement in the preamble to be a statement of a desired process for making the article, but the body of the claim does not rely on the preamble for completeness.

6. The applicant argues that there is a difference between reciting a "wrapper paper" and a "twin wire type wrapper paper", in the preamble of the claims and

therefore this difference should be given patentable weight. The examiner maintains his position (see arguments below from prior office actions).

7. The applicant alleges that because the prior art paper was manufactured using a different process, that the product cannot be the same (see Remarks 1/7/2009, page 7, last paragraph – page 8). This is a product by process argument, but the claims are not in product by process form. Therefore, the process used is not being considered for patentability. Should the claims be considered to be product by process, the examiner believes that no evidence has been presented that the product of the prior art is different from the product as currently claimed. In particular, the applicant argues that one of ordinary skill would not use a twin wire former to make a cigarette wrapper. First, this argument is moot due to the disclosure by the applicant that even using the more typical Fourdeiner paper making system would produce only a gradual change in concentration through the paper layers. Second, there is no evidence presented that one of ordinary skill would not use a twin-wire system to make cigarette paper, as it is a type of wrapping paper and encompasses a wide range of porosities. Third, Yamazaki discloses making handsheets, which is an extremely rapid method of making paper that would not produce the gradient of calcium carbonate that the applicant has argued would be formed on a Fourdeiner paper machine. Therefore, it would have been obvious that the handsheet made by Yamazaki would have a very uniform distribution of calcium carbonate.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 7 and 2-4 rejected under 35 U.S.C. 102(b) as being anticipated by EP 0791688 to Yamazaki ("Yamazaki"). Yamazaki teaches a cigarette paper with at least 30 g/m² of calcium carbonate [paragraphs 16 and 34] and at least 3% by mass of potassium or sodium citrate burn adjusting agents [table 4; paragraph 68]. However, Yamazaki does not expressly disclose that the amount of calcium carbonate in a surface layer (a layer in the thickness direction of 18-20% by mass) on each of a top side and a bottom side of the wrapper paper is less than the amount of calcium carbonate contained within the wrapper paper. However, it would be inherent in the invention of Yamazaki that calcium carbonate would be contained throughout the entire cross-section of the paper. This would inherently result in the top and bottom layers (a total of 40% of the paper mass) having less than the total amount of calcium carbonate because some of the calcium carbonate would be contained within the center of the paper raising the total amount of calcium above that which is contained only in the surface.

Claim Rejections - 35 USC § 103

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
11. Claims 2-4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent office publication EP 0791688 to Yamazaki ("Yamazaki") in view of Smook (Handbook for Pulp & Paper Technologies, section 20.7).
12. Yamazaki teaches making handsheets of a cigarette paper with at least 30 g/m² of calcium carbonate [paragraphs 16 and 34] and at least 3% by mass of potassium or sodium citrate burn adjusting agents [table 4; paragraph 68], but does not teach that the paper should be made on a twin wire paper forming machine nor is it expressly disclosed that the top and bottom surface layer have less calcium carbonate than within the wrapper paper.
13. It would have been obvious to one of ordinary skill in the art at the time of invention that the handsheet of Yamazaki would have calcium carbonate evenly distributed throughout the paper and result in the surface layers having less calcium carbonate than the entire paper.
14. Regarding the method of forming by using a twin wire forming machine, although Yamazaki discloses making handsheets, the steps and parameters for the process for making the paper do not add patentable details to this invention, as no structural characteristics are association with the step in the specification. As such, this is a "product by process" claim.

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985), (MPEP 2113).

"The Patent Office bears a lesser burden of proof in making out a case of *prima facie* obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983) ...

"[T]he lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).

15. Although the applicant indicates that the method of forming may impart structural characteristics, the disclosure regards only paper formed by twin wire forming versus on sided wire formation and does not discuss other paper making methods, such as the making of handsheets. Therefore, it is unclear if any structural differences would exist between the handsheets disclosed by Yamazaki and paper formed on a twin wire apparatus. It would have been obvious to one of ordinary skill in the art that the

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handsheet produced would not have had significant variation between surface and interior regions as the handsheet process is very rapid.

16. In addition, it would have been obvious to one of ordinary skill that the paper of Yamazaki could be made using standard paper production equipment. One of the well known methods of making tissue papers (a category that includes cigarette papers), includes twin-wire formers (Smook, page 316-317 and 319, especially "Modern Tissue Formers" on page 317). Therefore, the paper of Yamazaki, produced on standard paper making machines, would obviously have the same attributes as that of the instant invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL J. FELTON whose telephone number is (571)272-4805. The examiner can normally be reached on Monday to Friday, 7:30 AM to 4:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Phillip C. Tucker can be reached on 571-272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael J Felton/
Examiner, Art Unit 1791

/Philip C Tucker/
Supervisory Patent Examiner, Art Unit 1791